



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,369	02/28/2000	Takayuki Shinohara	49657-625	9468

20277 7590 07/06/2006

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

CONTEE, JOY KIMBERLY

ART UNIT	PAPER NUMBER
----------	--------------

2617

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/514,369

Applicant(s)

SHINOHARA ET AL.

Examiner

Joy K. Contee

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-19 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-7,9-19 have been considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3,6,7,9-15,17 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Gafken, US Patent No. 6,026,016.

Regarding claims 1,6 and 12, Gafken discloses a memory system for a portable telephone including a signal transmission/reception portion for transmitting and receiving a signal and a control portion for controlling at least a signal transmission and reception operation of said transmission/reception portion, comprising:

a random access memory (RAM) providing a working area for said control portion (col. 3,lines 51-64); and

Art Unit: 2617

a flash memory including a memory array for storing a program for said control portion (CPU) and at least transmission and reception data in a non-volatile manner under a control of said control portion, said memory array being divided into a plurality of storage units, and a register, provided commonly to the respective storage units, having information in a storage unit of said plurality of storage units transmitted thereinto and allowing serial readout of the transmitted information and allowing serial readout of the transmitted and stored information (and integrated in a control unit) (col. 3,lines 37-50,line 66 to col. 4,line 13 and line 48- col. 5,line 15 and col.9,lines 28-40 and see Fig. 9).

Regarding Claim 2, Gafken teaches the memory system for the portable telephone according to claim 1, wherein said random access memory and said flash memory are coupled to an internal bus interconnecting said control portion and said signal transmission/reception (col. 3,lines 37-50,line 66 to col. 4,line 13 and line 48- col. 5,line 15 and col.9,lines 28-40).

Regarding Claim 3, Gafken teaches the memory system for the portable telephone according to claim 2 comprising a bus converting circuit connected between said file storage flash memory and said internal bus and functioning as an interface circuit for said file storage flash memory (col. 3,lines 37-50,line 66 to col. 4,line 13 and line 48- col. 5,line 15 and col.9,lines 28-40).

Regarding Claim 4, Gafken teaches the memory system for the portable telephone according to claim 3, wherein said file storage flash memory and said bus converting circuit are integrally formed into a memory card (Fig.43 shows a memory card, and the bus converting circuit could be part of the input/output

Art Unit: 2617

circuit shown as 1/O in Fig.43; Col. 34, Lines 11-13) attachable and detachable to and from said portable telephone.

Regarding Claim 7, Gafken teaches the memory system for the portable telephone according to claim 1, wherein said flash memory comprises an AND type flash memory (col. 3,lines 37-50,line 66 to col. 4,line 13 and line 48- col. 5,line 15 and col.9,lines 28-40).

Regarding Claims 9 and 13, Gafken teaches the memory system for a portable telephone according to claims 1 and 12, respectively, wherein a program stored in the storage unit of said plurality of storage units is serially read out to the RAM to be executed (col. 3,lines 37-50,line 66 to col. 4,line 13 and line 48- col. 5,line 15 and col.9,lines 28-40).

Regarding Claims 10 and 14, Gafken discloses the limitations of claims 1 and 12, respectively, wherein said control portion performs a process using the RAM as an instruction memory to which the program is serially transferred from the flash memory (col. 3,lines 37-50,line 66 to col. 4,line 13 and line 48- col. 5,line 15 and col.9,lines 28-40).

Regarding Claims 11 and 15, Gafken discloses the limitations of claims 1 and 15,respectively wherein said control portion stores transmission and reception data into said RAM as a buffer memory, and transfers the stored transmission and reception data from the RAM to the flash memory (col. 3,lines 37-50,line 66 to col. 4,line 13 and line 48- col. 5,line 15 and col.9,lines 28-40).

Regarding claims 17 and 19, Gafken further discloses the memory system for a portable telephone according to claims 12 and 1, respectively, wherein the

Art Unit: 2617

storage units are each formed of a sector (col. 3, lines 37-50, line 66 to col. 4, line 13 and line 48- col. 5, line 15 and col. 9, lines 28-40).

4. Claims 4, 5, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Gafken, in view of Bowen et al. (Bowen), US Patent No. 5,367,571.

Regarding Claim 5, Gafken teaches the memory system for the portable telephone according to claim 3, but fails to explicitly disclose wherein said file storage flash memory is constituted of a memory card being attachable and detachable to and from said bus converting circuit.

In a similar field of endeavor, Bowen discloses wherein said file storage flash memory is constituted of a memory card being attachable and detachable to and from said bus converting circuit (see Fig. 7, #138 and col. 12, line 60 to col. 13, line 17).

At the time of the invention it would have been obvious to one of ordinary skill in the art to have modified Gafken to include a detachable memory card for the purpose of providing additional memory to increase the internal memory of a portable unit.

Regarding claims 16 and 18, Gafken discloses the limitations of claims 12 and 1, respectively, but fails to disclose wherein one unit of the storage units comprises a storage capacity ranging from 512 bytes to 2K bytes.

Bowen further discloses internal or external memory (i.e., for expansion) able to reach the size of memory in blocks or pages of 64K bytes (col. 120, lines 41-50).

Hence at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Gafken to include an extensive amount of storage capacity for the purpose of expanding size of stored data by using an expansion card, which is detachable.

Allowable Subject Matter

5. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sassa et al. US Patent No. 6,460,145, discloses a storage device data processing system and data writing and readout method.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joy K Contee whose telephone number is 571.272.7906. The examiner can normally be reached on M -F 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571.272.7905. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JC


JOY L. CONTEE
PATENT EXAMINER